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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,275	08/18/2005	Johannes Jung	3283-PAT	2960
30084	7590	12/28/2007		
DONN K. HARMS PATENT & TRADEMARK LAW CENTER SUITE 100 12702 VIA CORTINA DEL MAR, CA 92014			EXAMINER HOUSTON, ELIZABETH	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/528,275

Applicant(s)

JUNG, JOHANNES

Examiner

Elizabeth Houston

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/27/07 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16, 17 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for connector devices communicating in between first spring devices and second spring device, does not reasonably provide enablement for "connector devices communicating between only first spring devices or only second spring devices". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Although the specification states, "The connector devices link either only first or only second spring

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devices with each other, thereby forming a more or less straight line.", the drawings show otherwise and therefore it is not clear what is meant by this statement. For example Figure 2 shows that the connector device (12) communicates between both first and second spring devices rather than "only first" or "only second".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16, 17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Use of the terminology "only" in the limitation "connector devices communicate in between only first spring devices or only second spring devices" limits the invention in such a way that is not depicted in the drawings. Since the drawings show that the connector devices communicate between both first and second spring devices, this limitation does not distinctly claim the invention.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13-21 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogi et al (US 5,925,061), hereinafter referred to as Ogi.

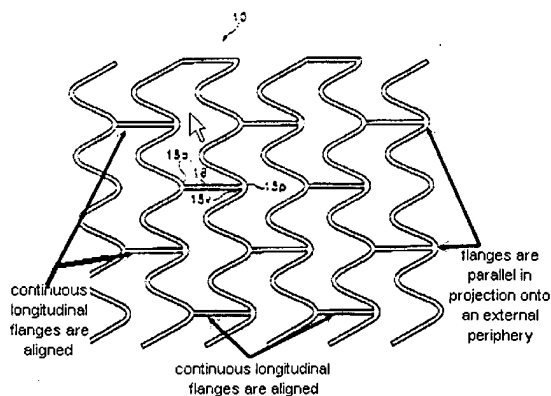
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8. Regarding claims 13 and 23, Ogi discloses the invention substantially as claimed including a stent defined by a plurality of adjacently positioned ring shaped elastic wall segments, each having a radial elastic structure, said wall segments comprising spring devices; gaps separating said wall segments; connector devices in a communication across said gaps linking adjacently positioned said wall segments; said connector devices (18) aligning along a length of said stent to form at least one continuous longitudinal flange (18) (the connectors align with each other in a pattern (see figure below) and they each individually form a longitudinal flange that is continuous from one ring to the other); said flange having said spring devices included therein (15p, 15v), thereby said flange providing means to maintain said length of said stent under tensile or compressive stress (col. 5, lines 17-21); and said connector devices having a width or thickness, said width or thickness being larger than a respective width or thickness of adjoining said spring devices (Col 8, line 23-35).

9. Regarding claims 14 and 15, Ogi discloses that the wall segments have first and second spring devices arranged in alternate fashion at an angle to each other wherein the spring segments are substantially rectilinear (fig. 1).

10. Regarding claims 16 and 17, Ogi discloses that the connector devices communicate in between only the first spring devices or only the second spring devices (fig. 1) (same as the instant invention does).

11. Regarding claims 18-21, Ogi discloses that several longitudinal flanges are parallel to each other in a projection onto an external periphery area of said stent arranged in a direction of the periphery, at distances from each other.



12. Regarding claim 24, Ogi discloses a unitary structure that is capable of being expanded with a balloon catheter (any stent is capable of balloon expansion, whether or not a balloon catheter is required to expand it).

13. Regarding claim 25, Ogi discloses that the shape memory material of the stent is Nitinol (col. 6, lines 14-19).

14. Regarding claim 26, Ogi discloses that the stent can also be made of a plastic (col. 6, lines 14-19).

15. Regarding claim 27, Ogi discloses that the periphery is machined to a smooth or polished surface (col. 5, lines 62-65).

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogi et al (US 5,925,061).

18. Ogi discloses that the connector devices have a larger width than the first and second spring devices, but fails to disclose that the connector devices are twice as wide as the spring devices ((Col 8, lines 23-35). Ogi does disclose a range of ratios varying from the connectors being half the width of the spring devices up to the connectors being one and half times the width of the spring devices.

19. It would have been obvious to one having ordinary skill in the art at the time of the invention to increase the ratio of the width thickness of the connectors to the width of the spring devices since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range only involves routine skill in the art. *In re Aller* 105 USPQ 233.

### ***Response to Arguments***

20. Applicant's arguments filed 09/27/07 have been fully considered but they are not persuasive.

21. Applicant's arguments state that Ogi lacks a continuous longitudinal flange because longitudinally it is not continuous and leaves numerous gaps. However as noted above, the limitation "continuous longitudinal flange" can be interpreted differently from applicant intends such that the connector (18) is a longitudinal piece and it is

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continuous (at least from one ring to the next). Therefore the claims as written are anticipated by Ogi.

22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "continuous flange, formed of the combination of connectors and adjacent adjoining spring sections") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh

alt  
12/18/07

  
Todd E. Manahan  
SPC 3731